



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,650	12/20/1999	ROBERT EVERETT PARKHILL	0500.9907201	1437

7590 04/08/2003

CHRISTOPHER J. RECKAMP
MARKISON & RECKAMP, P.C.
P.O. BOX 06229
WACKER DRIVE
CHICAGO, IL 60606-0229

EXAMINER

WOOD, WILLIAM H

ART UNIT

PAPER NUMBER

2124

DATE MAILED: 04/08/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

PRC

Office Action Summary

Application No.

09/466,650

Applicant(s)

PARKHILL, ROBERT EVERETT

Examiner

William H. Wood

Art Unit

2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claims 1-27 have been examined.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-5, 8-10, 12-17, 20-21 and 23-26 are rejected under 35 U.S.C. 102(a) as being anticipated by Netscape's "**SmartUpdate** Developer's Guide" March 11, 1999 herein referred to as **SmartUpdate**.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6, 7, 11, 18, 19, 22 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Netscape's "**SmartUpdate** Developer's Guide" as applied to claim 1 and in further view of Venkatesan et al. (USPN 6,209,093).

Examiner's Response

5. Objection to the abstract and the title over the word "method" is withdrawn.
6. Examiner simply stated the previous grounds of rejection above for the sake of brevity and clarity as the rejections have not changed.
7. Applicant's arguments with regard to claim 1 have been fully considered, but are not persuasive. Applicant argued 1) SmartUpdate lacks second and third processing entities and 2) update complete data is not provided to the second entity. First, Examiner notes the basic functionality of claim 1 is found in SmartUpdate chapter 1, page 2, first bulleted item at the top of the page. Here, it states users (first processing entity) go to a web site (second processing entity) which requires a plug-in, this web site contains a trigger script which determines if the user should locate and install the plug-in from where ever it may be (third processing entity). This is common procedure for web based internet usage. Scripts and JAR files are various elements found on those entities. Second, under the broadest reasonable interpretation of the claim limitation *providing update complete data, under the control of the third processing entity, for the second processing entity* SmartUpdate is applicable. This limitation just says the third entity provides an update complete indication to the second entity. Clearly the second entity knows the update is complete (data provided) and is therefore able to provide web access to the first entity (user). The third entity provides update complete info just by the fact that it is done and the first entity may continue with the second entity, a rather indirect, but still reasonable manner. The broad limitation does not preclude these scenarios.

Art Unit: 2124

8. Applicant's arguments with regard to claim 14 have been fully considered, but are not persuasive. Applicant argued 1) a web certificate is not provided for by SmartUpdate and 2) SmartUpdate does not send an URL. First, a web certificate is interpreted as simply a security measure and so is a Signed Java Class as a security measure. Further evidence of the similarity of various security measures is well known in the art as evidenced by Applicant disclosure (page 2, lines 15-24). Second, plug-ins come from the plug-in manufacture site as such a URL is required and therefore provided by SmartUpdate. Additionally, Applicant asserts mapping to the third processing entity is unclear. Examiner wrote the claim in such a manner as to map the language of claim 14 to claim 1. Claim 14 states a "processing entity", this element maps to the "third entity" of claim 1, which is rejected as stated above.

9. Applicant's arguments with regard to claim 3 have been fully considered, but are not persuasive. Applicant argued SmartUpdate does not provide for update confirmation data from the first entity to the third entity. First, Examiner maintains the original assessment of the claim that the first that it is in the interest of the first entity to indicate confirmation/status to the third entity in order to aid in a smooth file updating process. This interpretation of the claims is entirely acceptable under the broadest reasonable interpretation. Second, Examiner has thought of another interpretation of the claim language which is entirely acceptable under the broadest reasonable interpretation of the claim language. SmartUpdate in chapter 3, page 3 provides a dialog interface for asking the user for permission to make the update (note second paragraph under the figure). First entity (user) indicates permission (or confirmation) to

Art Unit: 2124

install or update a plug-in to the scripted computer (second entity), which of course lets the third entity make the update and thus providing the third entity with confirmation.

Examiner believes these observations make clear the broad nature of the claim language.

10. Applicant's arguments with regard to claim 4 have been fully considered, but are not persuasive. Applicant argued SmartUpdate does not provide update complete data by way of the first entity to the second entity. Examiner reiterates the position help above for claim 1. Clearly the second entity knows the update is complete (data provided) and is therefore able to provide web access to the first entity (user). The fact that the first entity wishes to continue to access the second entity provides the data to the second entity.

11. Applicant's arguments with regard to claim 8 have been fully considered, but are not persuasive. Applicant has clarified what was meant by "confirmation data" (Amendment filed 29 January 2003: page 9, lines 1-5). However, Examiner does not believe this interpretation of "confirmation data" precludes the reasonable interpretation of "confirmation data", Examiner set forth under the broadest reasonable interpretation of the claim language. As such, Examiner maintains the previous rejection.

12. Applicant's arguments with regard to 6 have been fully considered, but are not persuasive. Applicant argued Venkatesan did not indicate update information by using cookies to communicate. Examiner maintains Venkatesan did indicate update information using cookies to communicate (column 14, lines 54-56 and column 14, line 66 to column 15, line 2). As can be seen from the passage Venkatesan is

Art Unit: 2124

communicating using cookies. Furthermore, Venkatesan system is determining whether a system should receive updates or not based on communications involving cookies. Applicant argues this is not update information. However Examiner submits the information is being used in a system for making updates and therefore it is indeed update information.

13. Applicant's arguments with regard to 7 have been fully considered, but are not persuasive. As has been shown above cookies can be used for communicating in an update system, as a combination with SmartUpdate entity communication has been shown as well.

14. Applicant's arguments with regard to 11 have been fully considered, but are not persuasive. In response to applicant's argument that there is no suggestion to combine the references, Examiner notes Applicant did not address the previously stated reasoning for combination and as such maintains the previous position. The combined references teach cookies and communicating between processing entities.

SmartUpdate communicates between entities. Venkatesan uses cookies for communicating. Additionally, Applicant indicates a discussion of a "closed loop system". Examiner is unsure to what this refers.

15. The above response arguments are believed to cover all the claims to which they are directed and any dependent claims. Further, the above statements are believed to answer as clearly as possible the issues raised by Applicant.

Art Unit: 2124

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

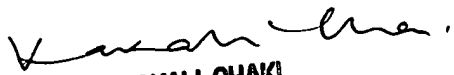
Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Wood whose telephone number is (703)305-3305. The examiner can normally be reached 7:30am - 5:00pm Monday thru Thursday and 7:30am - 4:00pm every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703)305-9662. The fax phone numbers for the organization where this application or proceeding is assigned are (703)746-7239 for regular communications and (703)746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

William H. Wood
March 30, 2003


KAKALI CHAKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100